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OFFICE OF PETITIONS

In re Application of	:	
Hiroyuki Hagano et al.	:	
Application No. 10/622,776	:	DECISION ON RENEWED
Filed: July 21, 2003	:	PETITION PURSUANT TO
Attorney Docket No. 26D-010	:	37 C.F.R. § 1.181(A)
Title: RESIN MEMBER AND METHOD	:	
OF MANUFACTURING THE SAME	:	

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.181(a), filed September 20, 2007, to withdraw the holding of abandonment.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed January 24, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees¹. Accordingly, the above-identified application became abandoned on April 25, 2007. A Notice of Abandonment was mailed on May 23, 2007.

An original petition was filed on June 13, 2007, and was dismissed via the mailing of a decision on September 12, 2007 for failure to establish non-receipt of the Office communication.

¹ See MPEP § 710.02(e).

RELEVANT PORTION OF THE MPEP

MPEP §711.03(c)(I)(A) sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement (emphasis added). For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

ANALYSIS

The showing in this renewed petition is not sufficient to withdraw the holding of abandonment because Petitioner has again failed to establish non-receipt of the Office communication.

With the original petition, Petitioner included a statement that a thorough search of the file jacket and docket records was conducted. Petitioner further included a copy of a screenshot of the "Posz Law Group Case Tracking System," which was asserted to serve as the docket record where the non-received Office

communication would have been entered and docketed, had it been received. The docket record that was provided with the original petition was not legible.

With this renewed petition, Petitioner has submitted a legible copy of the docket record.

The submission has been reviewed, and it does not appear that this submission comprises a docket record where the nonreceived Office communication would have been entered had it been received and docketed. The electronic file has been reviewed, and it is clear that a Notice to File Missing Parts of Nonprovisional Application was mailed on November 17, 2003, a Restriction Requirement was mailed on October 7, 2005, a non-final Office action was mailed on January 18, 2006, and a Final Office action was mailed on July 18, 2006; yet none of these mailings appear in the docket record. As such, the "Posz Law Group Case Tracking System" does not comprise a docket record where the nonreceived Office communication would have been entered had it been received and docketed.

This screenshot contains a section that is entitled "Allowance/Issue Fee," and contains fields entitled "Allowed," "Fee Due," "Paid," and "Received Postcard." Each of these fields is blank, and Petitioner has placed a notation on this screenshot that reads "the notice of allowance would have been entered here if it had been received and docketed." However, it does not appear that this is necessarily the case: the screenshot also contains a section entitled "Missing Parts," and each of the fields that are entitled "mailed," "due," and "sent" are blank, however there is no doubt that the Notice of Missing Parts was received; on November 17, 2003 a response to this mailing, executed by Petitioner, was received in the Office. Consequently, it does not appear that all Office communications that are received are entered and docketed into the "Posz Law Group Case Tracking System."

It follows that the present petition must be **DISMISSED**.

It does not appear that Petitioner will be able to meet the requirements of Delgar. As such, Petitioner may wish to strongly consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b).

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a) and/or Petition Under 37 C.F.R. § 1.137(a) and/or (b)." This is not a final agency action within the meaning of 5 U.S.C § 704. The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail², hand-delivery³, or facsimile⁴. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁵.

NOTICE:

Thereafter, there will be no further reconsideration of this matter^{6, 7}.

Petitioner's only relief is a petition under 37 C.F.R. §§ 1.137(a) and/or (b), and - having been made aware of this reality - any delay in promptly seeking relief under 37 C.F.R. § 1.137 may be considered evidence of intentional delay and an absolute bar to revival.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

7 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

Decision on Renewed Petition pursuant to 37 C.F.R. § 1.181(a)

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225⁸. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁸ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.